

This Opinion is Not a
Precedent of the TTAB

Mailed: October 18, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Niraj R. Mehta
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Serial No. 88453022
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Neil M. Batavia of Dority & Manning, P.A. for Niraj R. Mehta.

Frank Lattuca, Trademark Examining Attorney, Law Office 109,
Michael Kazazian, Managing Attorney.

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Before Cataldo, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Niraj R. Mehta (“Applicant”) seeks registration on the Principal Register of the proposed standard character mark VOTESAPP for “Online social networking services accessible by means of downloadable mobile applications” in International Class 45.¹

¹ Application Serial No. 88453022 was filed on May 30, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the proposed mark in commerce. The application drawing displays the proposed mark as “VotesApp.” “Our presentation of the mark in all uppercase letters reflects the fact that a term registered as a mark in ‘standard character’ form is not limited to any particular font style, size, or color.” *In re Calphalon Corp.*, 122 USPQ2d 1153, 1154 n.1 (TTAB 2017) (citing *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, n.1 (TTAB 2013)).

The Trademark Examining Attorney has refused registration of Applicant's proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of the services identified in the application.

Applicant appealed when the Examining Attorney made the refusal final, and Applicant and the Examining Attorney have filed briefs.² We reverse the refusal to register.

I. Record on Appeal³

The sparse record includes a Wikipedia entry defining "Social networking service;"⁴ a dictionary definition of the word "app;"⁵ webpages from social networks pertaining to user voting or polling;⁶ and USPTO electronic records regarding third-party registrations of various VOTE-formative marks.⁷

² Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's brief appears at 4 TTABVUE. The Examining Attorney's brief appears at 6 TTABVUE.

³ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO"). In addition to the materials listed below, the Examining Attorney made of record pages from the website at votesapp.de. August 21, 2019 Office Action at TSDR 2-5. Applicant subsequently denied that this was his website, or was affiliated with him, February 20, 2020 Response to Office Action at TSDR 1, and the Examining Attorney accepted his representations. March 8, 2020 Office Action at TSDR 1. Because the Examining Attorney withdrew his reliance on these webpages, we have not considered them in our decision.

⁴ February 20, 2020 Response to Office Action at TSDR 2-26; September 8, 2020 Response to Office Action at TSDR 2-26. It was unnecessary for Applicant to make the same Wikipedia entry of record twice.

⁵ March 8, 2020 Office Action at TSDR 2-3 (THE AMERICAN HERITAGE DICTIONARY).

⁶ *Id.* at TSDR 4-18.

⁷ September 8, 2020 Response to Office Action at TSDR 27-34. Applicant attached USPTO electronic records regarding these registrations to his appeal brief. 4 TTABVUE 16-24. The

Applicant also provided responses to the Examining Attorney's requests for information pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b),⁸ which stated, among other things, that his service is "directed toward 'getting out the vote' (GOTV);" that "[s]eparate and apart from in-person canvassing activities, the service provides the ability to socialize a user's self-disclosed vote status (voted, not voted, registered, etc.) amongst their contacts;" and that the "service creates a non-political interface that provides the vote status of contacts that utilize the service."⁹

II. Analysis of Mere Descriptiveness Refusal

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits registration on the Principal Register of "a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive . . . of them," unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).¹⁰ "A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services." *In re Fallon*,

Board strongly discourages this practice. "Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or convenience to the Board. It is neither." *In re Michalko*, 110 USPQ2d 1949, 1950 (TTAB 2014). As the Board explained in *Michalko*, "[w]hen considering a case for final disposition, the entire record is available to the panel," and "[b]ecause we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application," which requires "more time and effort than would have been necessary if citations directly to the prosecution history were provided." *Id.* at 1950-51.

⁸ March 8, 2020 Office Action at TSDR 1.

⁹ September 8, 2020 Response to Office Action at TSDR 1.

¹⁰ Applicant does not claim that his mark has acquired distinctiveness.

2020 USPQ2d 11249, at *7 (TTAB 2020) (quoting *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018) (citing *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978)). “A mark need not immediately convey an idea of each and every specific feature of the goods [or services] in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods [or services].” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *Gyulay*, 2 USPQ2d at 1010).

“Whether a mark is merely descriptive is ‘evaluated in relation to the particular goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use,’” *Fallon*, 2020 USPQ2d 11249, at *7 (quoting *Chamber of Commerce*, 102 USPQ2d at 1219) (internal quotation omitted)), and “not in the abstract or on the basis of guesswork.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513) (citing *Abcor Dev.*, 200 USPQ at 218)). “We ask ‘whether someone who knows what the goods and services are will understand the mark to convey information about them.’” *Id.* (quoting *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted))). A mark

is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *Id.* (citing *Fat Boys*, 118 USPQ2d at 1515).

Applicant's proposed mark VOTESAPP combines the two words VOTES and APP into one. "We must 'consider the *commercial impression* of a mark as a whole.'" *Fallon*, 2020 USPQ2d 11249, at *7 (quoting *Real Foods*, 128 USPQ2d at 1374). "In considering [the] mark as a whole, [we] 'may not dissect the mark into isolated elements,' without consider[ing] . . . the entire mark," *id.* (quoting *Real Foods*, 128 USPQ2d at 1374) (internal quotation omitted), "but we 'may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.'" *Id.* (quoting *Real Foods*, 128 USPQ2d at 1374) (internal quotation omitted). "Indeed, we are 'required to examine the meaning of each component individually, and then determine whether the mark as a whole is merely descriptive.'" *Id.* (quoting *DuoProSS*, 103 USPQ2d at 1758).

"If the words in the proposed mark are individually descriptive of the identified [services], we must determine whether their combination 'conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.'" *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1515-16) (internal quotation omitted). "If each word instead 'retains its merely descriptive significance in relation to the [services], the combination results in a composite that is itself merely descriptive.'" *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1516) (internal quotation omitted).

“Evidence of the public’s understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications.” *Id.* (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)). “These sources may include [w]ebsites, publications and use in labels, packages, or in advertising materials directed to the goods [or services].” *Id.*, at *7-8 (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (internal quotation omitted)).

“It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services.” *Id.*, at *8 (quoting *Fat Boys*, 118 USPQ2d at 1513). “If such a showing is made, the burden of rebuttal shifts to the applicant.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513). “The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513).

We begin by considering the descriptiveness of the words VOTES and APP that form Applicant’s proposed mark. There is no doubt that APP is descriptive of services identified as “Online social networking services accessible by means of downloadable mobile applications.” An “app” is a “computer application,”¹¹ and we agree with the Examining Attorney that when “app” appears as part of Applicant’s proposed mark, it “is descriptive of applicant’s social networking services which applicant states will be made available via [a] ‘downloadable mobile application.’” 6 TTABVUE 2.

¹¹ March 8, 2020 Office Action at TSDR 2 (THE AMERICAN HERITAGE DICTIONARY).

The word VOTES is quite another matter. There is no definition of the word in the record, but we take judicial notice that “vote” is both a verb meaning “to make an official choice for or against someone or something by casting a ballot, raising your hand, speaking your choice aloud, etc.,” and a noun meaning “a usually formal expression of opinion or will in response to a prompted decision, especially: one given as an indication of approval or disapproval of a proposal, motion, or candidate for office.”¹²

The Examining Attorney argues that “the term VOTES describe [sic] the subject matter of applicant’s services,” *id.* at 3, citing multiple Board cases in which marks such as PSYCHOLOGY PRESS for books in the field of psychology and WEATHER CHANNEL for television programming and weather information services were found to be merely descriptive of the subject matter of the relevant goods or services. He claims that “the information provided by the applicant clearly shows that the term VOTES describes a key feature of the services,” *id.*, that “the term VOTES does in fact convey information about a feature and subject matter of the services, and is therefore merely descriptive thereof,” *id.* at 4, and that “the term VOTES is directly descriptive of the subject matter of the social network, specifically whether users have cast votes” *Id.*

¹² MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on October 18, 2021). “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions.” *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *7 n.29 (TTAB 2019).

The word VOTES in Applicant’s proposed mark clearly refers in some way to the act or results of voting, but we disagree with the Examining Attorney that it “is directly descriptive of the subject matter of the social network, specifically whether users have cast votes” *Id.* That meaning of VOTES is not at all apparent on the face of the mark, and the Examining Attorney relies solely on Applicant’s statements during prosecution that his service “provides the ability to socialize a user’s self-disclosed vote status (voted, not voted, registered, etc.) amongst their contacts,” and “creates a non-political interface that provides the vote status of contacts that utilize the service.”¹³ Those statements, standing alone, are insufficient to establish that the word VOTES in Applicant’s proposed mark would be understood to have such a descriptive meaning by a consumer who knows that the involved services are “Online social networking services accessible by means of downloadable mobile applications.”

“Whether a mark is merely descriptive or not is ‘determined from the viewpoint of the relevant purchasing public,’” *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1090 (Fed. Cir. 2005) (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)), and purchasers of the identified services are unaware of Applicant’s statements and the other matters in the application’s file history. *See, e.g., In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 479, at *11 (TTAB 2021) (“We cannot assume that consumers of Applicant’s goods will be aware that its identification is . . . restricted [to exclude transparent goods], and the restriction is not controlling of public perception” of the applicant’s CLEAR mark for various Class

¹³ September 8, 2020 Response to Office Action at TSDR 1.

18 goods), *appeal docketed*, No. 21-2115 (Fed. Cir. July 2, 2021); *cf. In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *11 n.38 (TTAB 2020) (consumers are unaware of descriptions of marks); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1188 (TTAB 2018) (the “public is unaware of disclaimers that ‘quietly reside’ in the records of the Office”) (quoting *In re Wada*, 48 USPQ2d 1689, 1692 (TTAB 1998)).

The Board “must consider a mark in its commercial context to determine the public’s perception,” *N.C. Lottery*, 123 USPQ2d at 1709 (internal quotation omitted), including its use in public-facing materials such as “websites and publications, and an applicant’s own specimen of use and any explanatory text included therein.” *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2019) (citations omitted). The Examining Attorney issued the refusal to register before Applicant submitted a specimen, and the Examining Attorney did not make of record any materials, such as a website, reflecting the proposed mark’s use in its commercial context. Section 1209.02 of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) (July 2021) instructs examining attorneys to “examine §1(b) applications for registrability under §2(e)(1) according to the same procedures and standards that apply to any other application,” and notes that “the fact that [an] applicant has filed an intent-to-use application does not limit the examining attorney’s evidentiary options, nor does it shield an applicant from producing evidence that it may have in its possession.” *Id.* (quoting *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006)). In response to the Examining Attorney’s request for “fact sheets, brochures, and/or advertisements”

regarding the services,¹⁴ Applicant stated that such materials “are not yet available,” and explained that he “believes that its [sic] services feature new technology so Applicant is unaware of any competing services.”¹⁵ The Examining Attorney was of course free to make final the descriptiveness refusal, but he remained obligated to “support the refusal with appropriate evidence,” *id.*, and ran the risk that the available record evidence was insufficient.

On the record made by the Examining Attorney, we cannot find that the word VOTES in Applicant’s proposed mark has the descriptive meaning attributed to it by the Examining Attorney from the standpoint of the relevant purchasing public for Applicant’s services. We are constrained to agree with Applicant that the proposed mark as a whole “has no recognized meaning in connection with social networking services and the relationship between the terms ‘VOTES’ and ‘APP’ is not immediately clear,” and that the mark “requires consumers to exercise mature thought and imagination to arrive at a conclusion about the mark’s significance in connection with the identified social networking services.” 4 TTABVUE 7. There is nothing on the face of the mark that causes it to immediately convey that a feature of the identified social networking services is “the ability to socialize a user’s self-disclosed vote status (voted, not voted, registered, etc.) amongst their [sic] contacts,” *id.* at 9, and there is no record evidence to support a finding that the relevant purchasing public would so understand the word VOTES in the mark, or the mark as

¹⁴ March 8, 2020 Office Action at TSDR 1.

¹⁵ September 8, 2020 Response to Office Action at TSDR 1.

a whole. *Cf. N.C. Lottery*, 123 USPQ2d at 1710 (where the applicant's promotional materials for its FIRST TUESDAY lottery game and services contained statements such as "New scratch-offs the first Tuesday of every month," the commercial context of the mark's use "demonstrate[d] that a consumer would immediately understand the intended meaning of FIRST TUESDAY.").

Accordingly, we find that the Examining Attorney did not establish a prima facie case that Applicant's proposed mark VOTESAPP is merely descriptive of the identified social networking services. To the extent that any "doubts exist as to whether [the] term is descriptive as applied to the . . . services for which registration is sought," *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994), we resolve those doubts "in favor of [A]pplicant and pass the mark to publication with the knowledge that a competitor of [A]pplicant can come forth and initiate an opposition proceeding in which a more complete record can be established." *Id.*

Decision: The refusal to register is reversed.